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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/891,486 | 06/25/2001 | Hideo Yokota | 8305-210US (NP102-1) | 9376 |

570 7590 10/04/2002

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PHILADELPHIA, PA 19103

EXAMINER

MCAVOY, ELLEN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1764

DATE MAILED: 10/04/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

TE-19

Office Action Summary

Application No.

09/891,486

Applicant(s)

YOKOTA ET AL.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

Claims 1-7, 9-15 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 has been amended to "A cutting or grinding oil composition for a minimal quantity lubrication system comprising at least 20 percent by mass of an ester based on the total amount of the composition, ..." which is indefinite. It is not clear what comprises up to 80 percent of the composition. Although the open-ended claim language "comprising" allows for the addition of other components to the composition even in major amounts, the composition claimed must add up to 100 percent in order to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Newly added independent claims 17 and 20 contain similar language and are also indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zielinski (5,756,430) in combination with Ott (6,085,782).

Zielinski discloses a mist oil lubricant which distributes fine droplets of oil compositions in aerosol form to the areas of various machine elements to be lubricated. The compositions comprise (A) 90-95 percent by weight of an ester oil having a viscosity of 10-150 cSt at 40°C, (B) 3-5 percent of an additive selected from rust inhibitors, corrosion inhibitors, anti-wear agents, anti-foam agents, antioxidants, demulsifiers, extreme pressure agents and mixtures thereof, and (C) 1-5 percent of a polyisobutylene stray mist suppressant. See the claims. Suitable ester oils are set forth in column 2, lines 23-41. The examiner is of the position that the mist oil lubricant of Zielinski clearly meets the limitations of the cutting and grinding oil compositions of the claims which have been amended to a kinematic viscosity of 1 to 100 mm²/s at 40°C. As previously set forth, Ott is added only to teach that "minimal quality lubrication" is a term known in the lubricant art for tool working. See column 1, lines 10-67. Ott teaches that oil compositions can be supplied to workpieces in an amount of 20 ml per hour. See column 2, top. The examiner is of the position that the mist oil lubricant of Zielinski can be applied to a workpiece in such a manner if so desired.

Claim Rejections - 35 USC § 103

Claims 1-7, 9-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama et al (5,171,903) in combination with Ott (6,085,782).

Applicants' arguments filed 26 June 2002 have been fully considered but they are not persuasive. As previously set forth, Koyama et al ["Koyama"] disclose a lubricating oil composition for plastic working, metal working, or for cutting and grinding which comprises (i)

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a linear olefin having 6 to 40 carbon atoms as a base oil, (ii) at least one member of compounds selected from the group consisting of alcohol, glycol, polyalkylene glycol, and a derivative of polyalkylene glycol and fatty acid, and (iii) at least one of phenolic compounds and amine compounds. See column 2, lines 3-54. Component (ii) includes fatty acid esters of polyethylene glycol which may be added to the composition in an amount of 0.05 to 50 weight % of the entire composition. See column 16, lines 25-51. The examiner maintains the position that the ester component of Koyama meets the limitations of the ester component of the claims. The composition of the prior art also includes alkyl-substituted phenols as component (iii) in an amount of 0.1 to 2.0 weight % based on the entire composition. See column 16, line 52, to column 17, line 50. This meets the limitation of the oiliness component of the claims when it comprises (D), compounds represented by formula (1) set forth in dependent claim 10. The composition of Koyama can also be blended with a suitable quantity of well-known oiliness agents, extreme-pressure agents, rust inhibitors, corrosion inhibitors, and the like. See column 17, line 52 to column 18, line 2. Thus, the examiner maintains the position that the composition of Koyama meets the limitations of the cutting and grinding oil composition of the claims. Ott is added to teach that "minimal quality lubrication" is a term known in the lubricant art for tool working. See column 1, lines 10-67. Ott teaches that oil compositions can be supplied to workpieces in an amount of 20 ml per hour. See column 2, top. The examiner is of the position that the cutting and grinding oil composition of Koyama can be applied to a workpiece in such a manner if so desired.

Conclusion

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

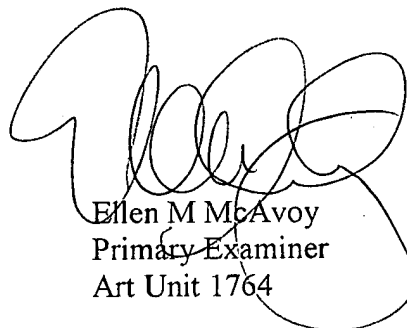
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
October 1, 2002